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09/112,131	07/08/1998	JAY S. WALKER	WD2-96-002X1	6549

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EXAMINER

NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/112,131	Applicant(s) Walker et al.
Examiner Cuong H. Nguyen	Art Unit 3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Oct 4, 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 177-189 and 193-195 is/are pending in the application.

4a) Of the above, claim(s) 193 and 194 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 177-189 and 195 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892)

18) Interview Summary (PTO-413) Paper No(s). _____

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) Other: _____

DETAILED ACTION

1. This Office Action is the answer to the small entity claim, amendment & response, received on 10/04/2002 which papers have been placed of record.
2. Claims 177-189, and 195 are pending in this application.

Response:

3.A. The examiner withdraws the use of **Nielson** reference in any rejection because of the Affidavit of the inventors. USPTO (or any US company) 's hierarchy would include limitations of claim 195; furthermore, another very familiar evidence in daily life is **Yellow Pages** also covers the claimed subject matter.

B. Referring to the argument on the paper received on 4/09/2001 (page 3, 2nd paragraph), that "...nothing in **USPTO procedure** entails the claimed steps of "receiving a first expert "qualification" corresponding to the first expert", nor "transmitting the first expert "qualification" to a second expert", nor "receiving a "signal" from a second expert that indicates approval of the first expert "qualification"", the examiner submits that these kinds of actions have been widely used in many areas (**USPTO might not expressly say that limitation exactly as claimed languages, neither published those ideas**, but in its telephone directory, or organization chart, clearly showing a hierarchical order that reflecting above limitations, i.e.,

art unit 705, sub-class 26 defined the listed examiners having "e-shopping" knowledge/skills to examining this kind of specific cases, the supervisor of this art unit (A.U. 3625) has a senior level of patent examining functions and familiarity with this skill levels; accordingly, she is the right one to give a second opinion about her examiner's qualification; furthermore, a director (as her boss) has more of this particular skills comparing to an ordinary examiner or a supervisor in these group art units (since most of the director and supervisor have climbed up the ranks from the same arts). Upon making decision about a consulted matter, a "YES" or "NO" answer has been given (this may be in oral, or in writing, or using an e-mail; equivalent to a communicating "signal"). USPTO 's method of doing business would be related to "expert qualification" comprising a first expert (examiner) and a second expert having authority to approve the first expert "qualification" (his supervisor). This has widely used/been available in public knowledge; this idea of doing business from USPTO would be implemented in cited references by one of ordinary skills in the art, it comprises hierarchical authorities.

C. The applicants argue that: "Furthermore, the **Harte** reference, being concerned with an instructional and testing device, has nothing to do with the claimed subject matter of a computer implemented expert matching method. In any case,

Harte certainly does not supply the element, lacking in the other art cited by the Examiner, of receiving a "signal" from a second expert that indicates approval of a first expert "qualification". The examiner submits that **Harte's** patent was submitted as an IDS (containing only that single reference) to PTO on this case for consideration. It was very surprised if this reference has nothing to do with this application.

D. Furthermore, see a well-known computer site of **eBay.com** for actions of: "...concerning steps of receiving a bid on an end user-request ..., ... transmitting such a bid ...". Accordingly, the examiner submits that an ordinary skills in the art would be able to modify these "bidding" ideas in various subject matters using at least **eBay's** reference although only "objects" are used for this purpose; the examiner submits that it would be analogous for bidding for "a service"; (bidding has been used at least in "reverse auction" from a US Patent, and applicants should be aware of it because same assignee/inventor is on this application). A motivation for "bidding an expert"/"essentially bidding for an expert's SKILL" is to gain potentially capable people for a specific purpose; that is what has been widely applied (in "**head hunting**" recruitment) since the past.

F. The examiner submits that all the limitations are not patentable since they lack of inventive steps, i.e. "Receiving a "signal" from a 2nd expert that indicates approval of a first expert "qualification"" (in this case,

just a "Y" or "N" "signal"; this "signal" could be transmitted through email, post-office mail, voice mail, .etc.); "allowing the end user to select an expert from the list" (4th para. Of page 4). The applicants may argue that "a claim may be patentable since its feature of allowing the end user to select an expert from a list is not taught or suggested by prior art"; actually, this analogous action is notoriously well-known: e.g., an end user select a specific expert from a telephone book such as a Yellow Page; wherein an action of selecting an expert (from a list/database) in a telephone Yellow Page is inherent).

4. The applicants also argue that: "claim 195 is submitted as being patentable over the prior art by virtue of its recitation (???) of "**receiving** at least one **bid** on the end user request **from** the at least one **expert**" (key words are bold-faced), and "**transmitting** the at least one **bid** to the end user" (key words are bold-faced). As above, these limitations simply **lack of inventive steps** (analogous actions for these limitations would be inherent in Dyson's article or in a newspaper "classified ads" wherein objects/experts were bargained/bidding from readers) (the examiner submits that an ordinary skills in the art would be able to modify these "bidding" ideas for various subject matters using at least eBay's reference although only "objects" are used for this purpose). A motivation for "bidding an expert"/"essentially bidding for an expert's SKILL" is to gain potentially capable people for a specific

purpose; that is what has been widely applied (e.g., in "head hunting" or **bidding a defense contract** (opinions are given from a variety of sources; 2nd sources/experts are among those contributing opinions) to select **from many different bids**) in the past.

5. It is reasonable that various modifications of prior art would be apparent to those skilled in the art at the time of invention without departing from the scope and spirit of these inventions. Although cited inventions may have been described in connection with specific preferred embodiments, it should be understood that their limitations as disclosed should not be unduly limited to such specific embodiments. Furthermore, in response to the amendment, the examiner submits court cases which are relevant to applicant's arguments.

Claim Rejections - 35 USC §101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

6. Claims 177-189, and 195 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A. The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere abstract ideas that do not apply, involve, use the

technological arts fail to promote/advance the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

B. Claimed invention must be within the "technological arts" [*Bowman* 61 USPQ2d 1669 published 6/12/2001 (BPAI)]; claims 177-189, and 195 are method claims; therefore, technological art MUST be used to advance to an inventive purpose.

C. Even mere recitation in the preamble or mere suggestion in a claim that a machine is performing some or all of the steps in the method is NOT ENOUGH to place claimed invention in the technological arts. The body of the claims must unambiguously recite that a machine/apparatus is performing the step(s) and/or is integrally involved in the process (i.e., a computer-implemented method) for the achieved effect (i.e., level of involvement, use, or advancement).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 195 is rejected under 35 U.S.C. § 102(b) as being anticipate by Esther **Dyson**.

Dyson's article disclose about managing communications between an expert and an end user, comprising:

- receiving a user request (via Amix) "a buyer might send a seller his data..." ;
- transmitting said request to an expert (via Amix) "a buyer might send a seller his data..." ;
- receiving a bid on the user from an expert (via Amix), see **Dyson**, "a sort of data auction, complete with bid and asked prices", or "soliciting bids for consulting services" ;
- transmitting said bid to said end user (via Amix), inherent in **Dyson**'s article "a buyer might send a seller his data..." ;
- notifying the selected expert of acceptance of the selected expert's bid (via Amix), inherent in **Dyson**'s article;
- receiving from the selected expert an expert answer responsive to the end user request (via Amix) "... advice about which brand is best..." ; and
- transmitting the expert answer to the end user (via Amix) "Amix will collect a percentage of each transaction from the seller..." .

Therefore, all claimed limitation are disclosed in **Dylon**'s article.

8. The field of application is "expert matching" with assistance of a computer system (see *in re Lyell* for a case law of automation a known process, on this issue - a

computer system is used to make that process organized and more accurate. An ordinary with skill in the art can simply look at the Yellow Pages to search for a specific expert, a corresponding address, a reference (this can be from a more reliable source standing for "2nd expert's opinion"; these actions can be done in his head or with a pencil and a pad .etc.).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 177-189, 195 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPTO organization, in view of **Canale et al.** (US Pat.5,619,648), Yellow Pages, and further in view of **Harte** (US Pat. 4,576,579).

A. Re. to claim 195: **Canale et al.** obviously suggest an expert matching computer for managing communications between an expert and an end user (see **Canale et al.'648**), the abstract; Figs.6, 7), comprising:

- inherent features of a controlling step for receiving an end user request (see **Canale et al.'648**), having a database for storing therein a plurality of expert "qualification" (see **Canale et al.'648, or Yellow Pages**),

each expert qualification associated with an expert address stored in the database and corresponding to a particular expert (see **Canale et al.'648, or Yellow Pages**);

- inherent features of classifying a request (see **Canale et al.'648, or Yellow Pages**);
- inherent features of providing an expert address which corresponds to a request's classification (see **Canale et al.'648/Yellow Pages**);
- inherent features of for identifying:
 - an expert corresponding to a request's field/classification; an identified expert address corresponding to the identified expert (these features of the claim are **well-known** in the art (e.g. a Patent & Trademark Office's examiner on internal telephone books who examines applications of a particular US Classification (for example, class 705 subclass 28); his art unit, Technology Center, his phone number, his Office location .etc.; see also **Harte** for implicit suggestions);

Canale et al. ('648)/Yellow Pages may not disclose exactly a claim's language in using his concept as claimed by the applicants.

However, all the claimed limitations are analogously well-known in the above field. For example, a step of controlling for receiving a request to grade a multiple choice test, it would define a testing level and selecting an appropriate test level questions (a requested expert qualification), it involves a computer using for testing

having a database for storing a plurality of test levels/(expert qualifications), each stored level/(different expert qualification) corresponding to an appropriate test/(expert of a plurality of sub-level experts), each stored test answer template/(expert qualification) being associated with an address stored in the database and corresponding to a test/an expert .etc. (see **Harte** for these implicit suggestions). Then, these steps are obviously involved in this test:

- selecting/searching the database to identify a test/expert corresponding to the requested test/qualification and an address corresponding to the identified test (see **Harte** for these implicit suggestions);
- requesting management 's approval of a specific test (a standard of qualification) to a corresponding level of grade; and means to receive a response on that matter (this is analogous to "receiving a "signal" from the second expert (e.g. from manager) that indicates approval of the first expert qualification (a specific test)", and similar as above to "receiving a "signal" from the set of experts (e.g. many supervisors) that indicates approval of the first expert qualification"),(this response also answers arguments on para.2,4-5 of page 4 in the amendment received on 9/05/2000.
- authenticating data (e.g. checking tester's I.D., and picture I.D., checking authorized personnel in a test room

.etc.); therefore, the examiner submits that this step is obvious in a placement test;

- guaranteeing payment to the selected test (e.g., a test fee is administered in order to take the test or in order to have test results); therefore, the examiner submits that this step is obvious in a placement test;

- initiating remittance of payment to a test (e.g., application accompanying a testing fee as initiation); therefore, the examiner submits that this step is obvious in a placement test;

- selecting the end user requests for test evaluation (e.g. a teacher, a student, an employer); therefore, the examiner submits that this step is obvious in a placement test;

- transmitting a portion of test result to the address corresponding to an identified result template (e.g. for adjusting the result in a test template); therefore, the examiner submits that this step is obvious in a placement test;

- receiving a test answer/result in response to the end user request (this means is notoriously well-known in the art for receiving a test result (i.e. a student would receive a test result from a teacher); therefore, the examiner submits that this step is obvious in a placement test;

- transmitting test answers to the end user (this means is notoriously well-known in the art for transmitting test

answers e.g. to an employer, or "to whom it may concern");
therefore, the examiner submits that this step is obvious in
a placement test.

In other words, these limitations could be done exactly by a computer system from a testing lab (**Harte's** patent results to these suggestions). One of ordinary skills in the art at the time of the invention would have found these claims' limitations would be very obvious with obvious steps as suggested by cited prior art; prior art's limitations are not necessary spelled-out exactly claimed languages, because these prior arts are also directed to a similar process for obtaining job applications from remotely located applicants. These prior arts are not limited to the described embodiments in these inventions. It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although these inventions have been described in connection with specific preferred embodiments, it should be understood that the invention as claimed should not be unduly limited to such specific embodiments.

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the same concept of testing a level/(an achievement) to perform functions as claimed; because all cited references would suggest using a similar means and applying a similar concept as a expert matching computer to select an appropriate

source for a specific solution. A motivation for "bidding an expert"/"essentially bidding for an expert's SKILL" is to gain potentially capable people for a specific purpose; that is what has been widely applied (in "head hunting" recruitments) since the past.

B. Re. to claims 177-189: USPTO also suggest these claims limitations because they "read-on" analogous steps of "expert matching" e.g. the USPTO Commissioner/the representative's attorney (the end user of a patent application), the examiner (an expert/master in his field by art unit/(classification subject), the Supervisory Patent Examiner (second expert who has a higher experience/authority compared to the first expert (his examiner). A patent application is transmitted to an examiner (first expert), he examines the case, and then get some advices from his SPE (second expert); this 2nd expert approves who would be an appropriate person in his art unit for the job of examining this particular case (e.g. depending on a specific subject matter such as insurance, e-shopping, e-coupons, banking, .etc., he appoints one of his examiner who is expert in this specific field; the SPE is always a senior, experience examiner who can guarantee his examiner 's level of expertise to the Commissioner/the representative's attorney (the end user). Therefore, this rationale/reference would be analogous to the procedure of the claim's language.

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the same concept of managing different skills in USPTO organization, with **Canale/Yellow Pages**, and **Harte**'s suggestions to perform functions as claimed; because USPTO applying an analogous concept as a expert matching to select an appropriate source for a specific solution. A motivation for proper managing an expert's SKILL is to achieve maximum results for agency's plans.

10. Claims 177-179, 185 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Levin et al.** (US Pat. 5,724,580).

Levin et al. obviously suggest a communication system that provides similar concept of the claimed invention (see **Levin et al.**, 5:49-67):

- receiving a first expert qualification (see **Levin**, Fig.2, ref. 124);
- selecting a 2nd expert qualification, the 2nd expert qualification is higher than the 1st expert qualification (see **Levin**, Fig.2, ref. 120);
- transmitting a first expert qualification to the 2nd expert (see **Levin**, Fig.2, ref.170);
- receiving a signal from the 2nd expert that indicates approval of the 1st expert qualification (see **Levin**, Fig.2 refs. 160, 166);
- receiving an end user request (see **Levin**, Fig.2, refs. 160, 166, 168);

- selecting a first expert based on an end user request (see **Levin**, Fig.2 refs. 160, 166, 168);
- transmitting a request to the first expert (see **Levin**, Fig.2 refs. 160, 166, 168);
- receiving an expert answer to that request; the expert answer containing information about the 2nd expert (see **Levin**, Fig.2 refs. 160, 166, 168);
- transmitting the expert answer to the end user (see **Levin**, Fig.2 refs. 160, 166, 168).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the same concept of communication of different skills in **Levin's** patent to achieve a specific need as claimed; because **Levin** applying an analogous concept as a expert matching to select an appropriate source for a specific solution. A motivation for proper communication for an expert's SKILL is to achieve maximum results for a specific need.

Conclusion

11. Claims 177-189, 195 are not patentable.
12. These provided references are considered pertinent to applicants' disclosure:
 - **Levin et al.** (US Pat. 5,724,580 with a priority date of 3/31/1995), about a method and a system of generating prognosis and therapy reports for coronary health management.
 - **Nielsen** (US Pat. 5,948,054 filed on 2/27/1996) published on 9/07/1999, about a method and a system for

facilitating the exchange of information between human users in a networked computer system.

- **Esther Dyson**, "Information, bid and asked", *Forbes*, v146, n4, p92(1), 8/20/1990; (from Dialog(R) file 47 acc. No. 03461059).
- **Benjamin Wright**, High-Tech juice keeps electronic emporiums humming, *Computerworld*, Framingham; 10/12/1992, 3 pages.
- Dr. Joel N. Orr, Join the Information Economy, *Computer-Aided Engineering*, 4/1992, pg.84.

13. Remarks:

About automating a manual activity:

The court held that providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art (using a computer "an automatic means" to "bid for expert" has been done manually in "head hunter"). *In re Venner*, 262 F.2d 91, 120 USPQ 193, 194 (CCPA 1958).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703) 305-4553. The examiner can normally be reached on Monday-Friday from 7:15 AM-3:15 PM.

Any response to this action should be mailed to:

Amendments

Commissioner of Patents and Trademarks

09/112,131
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or faxed to: (703) 746-7239 (Official)

Or: (703) 746-5572 (RightFax) (for informal or draft
communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park
II, 2121 Crystal Drive, Arlington, VA. 22202, 4th. Floor.

Any inquiry of a general nature or relating to the
status of this application should be directed to the Group
receptionist whose telephone number is (703) 305-3900.

Cuong Nguyen
Primary Examiner
Dec. 15, 2002